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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION

JAMES R. GLIDEWELL DENTAL
CERAMICS, INC. dba GLIDEWELL
LABORATORIES, a California
corporation,

Plaintiff,

vs.

KEATING DENTAL ARTS, INC., a
California corporation

Defendant.

AND RELATED
COUNTERCLAIMS.

Case No. SACV11-01309-D0C(ANx)

**PLAINTIFF JAMES R.
GLIDEWELL DENTAL CERAMICS,
INC. DBA GLIDEWELL
LABORATORIES' RESPONSE TO
DEFENDANT KEATING DENTAL
ARTS, INC.'S OBJECTIONS TO
DECLARATION AND EXPERT
REPORTS OF DAVID FRANKLYN
SUBMITTED IN SUPPORT OF
GLIDEWELL'S MOTIONS FOR
PARTIAL SUMMARY JUDGMENT**

Hearing

Date: December 17, 2012
Time: 8:30 a.m.
Ctmm: 9D, Hon. David O. Carter

Pre-Trial Conf.: January 28, 2013
Jury Trial: February 26, 2013

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1 **I. INTRODUCTION**

2 Plaintiff James R. Glidewell Dental Ceramics, Inc. dba Glidewell
3 Laboratories (“Glidewell”) hereby responds to the objections of Defendant Keating
4 Dental Arts, Inc. (“Keating”) to the Declaration and Expert Reports of David
5 Franklyn Submitted in Support of Glidewell’s Motions for Partial Summary
6 Judgment (“Objections”). In addition to the arguments discussed below, Glidewell
7 responds to Keating’s individual objections in a table format, attached as Exhibit A.

8 **A. The Court Should Overrule Keating’s Objections to Franklyn’s**
9 **Rebuttal Reports – Reports That Glidewell Did Not Even Submit**
10 **as Evidence in Support of its Motion**

11 Glidewell submitted a single declaration of David Franklyn in support of its
12 Motions for Summary Judgment (“Franklyn Declaration”). (Dkt. #90-1, Ex. N.)
13 Franklyn attaches one exhibit to his declaration – his CV. (Dkt. #90-18, Ex. 47.)
14 Glidewell did not submit Franklyn’s initial expert report, nor his two rebuttal
15 reports (one to Keating’s expert Lori Boatright and one to Keating’s expert Dr.
16 David Eggleston), as evidence in support of Glidewell’s Motions for Summary
17 Judgment. Nevertheless, Keating submitted the two rebuttal reports in connection
18 with its opposition papers (Dkt. ##125-13 and 125-14, Exs. 150 and 151) and then
19 devotes the majority of its Objections to seeking exclusion of the very reports that
20 Keating – not Glidewell – submitted. Keating, in other words, filed Franklyn’s
21 rebuttal reports for the sole purpose of objecting to them.

22 The Court should reject Keating’s blatant attempt to preview its motions *in*
23 *limine* in connection with Glidewell’s Motions for Summary Judgment.
24 Nevertheless, and the irrelevance of Keating’s objections to Franklyn’s rebuttal
25 reports notwithstanding, the objections Keating lodges against Franklyn’s rebuttal
26 reports fail for the following reasons, among others:

- 27 • Many of Keating’s objections to the form of statements in Franklyn’s
28 rebuttal reports that are not repeated in his declaration (for example, lack

of foundation, lack of personal knowledge and conclusory statements) make no sense. (*See* Dkt. #120 at 11:12-13:8) These statements were not proffered as evidence. They are part of an expert rebuttal report and need not be in evidentiary form.

- Keating's multiple inconsistent-with-prior-testimony objections are baseless. Keating complains that those portions of Franklyn's rebuttal reports recounting Franklyn's interviews with dentists conflicts with his deposition testimony because Franklyn testified that he had not spoken to any dentists. There is nothing, however, contradictory about the testimony; Franklyn interviewed the dentists identified in his rebuttal reports after his deposition was taken.
- Keating's hearsay objections are fatally flawed for two reasons. First, Glidewell does not introduce the reports as evidence; there is no testimony to which the hearsay rule could even apply. Fed. R. Evid. 402. Second, even if the statements in the rebuttal reports were testimony, Franklyn does not offer the statements of the dentists he interviewed for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); *United States v. Kirk*, 844 F.2d 660, 663 (9th Cir. 1988).
- Franklyn's statements in his rebuttal reports are not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in Glidewell's First Amended Initial Disclosures served on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. For the reasons discussed at length below (Section I.B) and in Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment, Keating's

timeliness objections should be overruled.

- Keating's numerous "legal conclusion" objections lack merit. As set forth in detail below (*See* Section I.F), utilizing attorney experts, including law professors like Franklyn, to proffer opinion testimony concerning such matters as the strength of a mark, similarity between marks, the potential for customer confusion, and other specialized issues pertinent to a trademark case is a commonly accepted practice. And, if the Court deems these objections persuasive enough to exclude Prof. Franklyn, it should exclude Keating's expert, Lori Boatright, for the same reasons.

Again, the Court does not need to consider Keating's specific objections to Franklyn's rebuttal reports because the reports are not proffered as evidence in support of Glidewell's motions. Instead, the Court's focus should properly be on the specific objections that Keating makes to the cited portions of Franklyn's Declaration¹ – the actual evidence that Glidewell submitted in support of its motions.

B. Glidewell Timely Served Franklyn's Declaration and the Content of Franklyn's Rebuttal Reports Was Timely Disclosed Pursuant to

¹ The first ten pages of Keating's Objection generally outlines the factual and legal reasons Keating claims portions of Franklyn's Declaration should be excluded from the record on Glidewell's Motion for Summary Judgment. In this introductory portion of the Objection, Keating does not specifically identify the evidence to which it objects. Keating only does so starting on page 26 of the Objection. Glidewell responds to the specific objections to the cited portions of Franklyn's Declaration. It is not for Glidewell nor the Court to guess what other portions of Franklyn's Declaration might be subject to Keating's generalized objections. *See Carmen v. San Francisco Unified Sch. Dist.*, 237 F.3d 1026, 1031 (9th Cir. 2001) ("[R]equiring the district court to search the entire record, even though the adverse party's response does not set out the specific facts or disclose where in the record the evidence for them can be found, is unfair. . . . If a district court must examine reams or file cabinets full of paper looking for genuine issues of fact, as though the judge were the adverse party's lawyer, an enormous amount of time is taken away from other litigants."); *Duke v. Atria, Inc.*, 2:03-CV-00934-DRB, 2005 WL 1514149, at *2 (M.D. Ala. June 27, 2005) (noting that "[s]ince [Defendant] does not particularize any objectionable 'evidence' in these pages of discussion, the Court declines appropriately to undertake the lawyer's task of specifying disputed evidence and the basis for any objection").

the Court's Scheduling Order

Keating argues that those portions of Franklyn's Declaration that rely on the content of Franklyn's rebuttal reports to Boatright and Dr. Eggleston (*i.e.*, Paragraphs 55-71) should be excluded because the rebuttal reports were not timely disclosed, but were disclosed in violation of the Court's denial of Glidewell's motion to amend the scheduling order, or perhaps the scheduling order itself. (Dkt. #120, p.1) This is false. Franklyn's Declaration was timely served in connection with Glidewell's Motions for Summary Judgment on November 19, 2012. (Dkt. #90-1, Ex. N.) Furthermore, the details of Franklyn's rebuttal reports were properly and timely disclosed on October 29, 2012, the last day to complete discovery. *See Etagz, Inc. v. Quiksilver, Inc.*, No-10-300-CV-DOC (C.D. Cal. Nov. 16, 2012), ECF No. 179 (denying motion to strike expert reports as untimely because report was served before discovery cut-off date); *see also Nuance Comms., Inc. v. ABBYY Software House*, C 08-02912 JSW MEJ, 2012 WL 2838431 (N.D. Cal. July 10, 2012) (denying motion to strike 25 witnesses disclosed on last day of discovery); *Russell v. Daiichi-Sankyo, Inc.*, CV 11-34-BLG-CSO, 2012 WL 1805038 (D. Mont. May 17, 2012) (holding that disclosure of fact witness made on day of discovery cut-off was timely); *ESM Techs., LLC v. Biova, LLC*, No. 10-3009-CV-S-RED (W.D. Mo. Mar. 21, 2012), ECF No. 209 (holding expert declaration and report filed on last day of discovery to be timely); *3Com Corp. v. Realtek Semi. Corp.*, C 03-2177 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24, 2008) (denying motion in limine to preclude testimony from third-party witnesses first disclosed on the final day of fact discovery); *Cyntegra, Inc. v. Idexx Labs., Inc.*, CV06-4170PSG (CTX), 2007 WL 5193736 (C.D. Cal. Sept. 21, 2007) (holding service of expert reports on the last day of discovery to be timely), *affirmed*, 322 F. App'x 569 (9th Cir. 2009); *Roe v. Nevada*, 621 F. Supp. 2d 1039, 1060 (D. Nev. 2007) (holding disclosure of fact witnesses on last day of discovery to be timely).

Keating argues that Franklyn's rebuttal reports should have been served on

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1 October 15, 2012. Although the parties, in their Rule 26(f) report, had proposed
 2 October 15 as the deadline for rebuttal expert reports, this date was not adopted by
 3 the Court and is not in the Scheduling Order. *Cf. Order, Etagz, Inc. v. Quiksilver,*
 4 *Inc.*, No. SACV 10-300 DOC (MLGx) (C.D. Cal. Nov. 16, 2012), ECF No. 179
 5 (“The Minute Order from the scheduling conference sets only one date, November
 6 5, 2012, as the expert discovery cutoff. The Court declines to find that the Minute
 7 Order also adopted all the sub-deadlines that were contained in the 26(f) Report,
 8 given that the Minute Order only includes the November 5, 2012, expert discovery
 9 cutoff date.”) (Dkt. #142, ¶ 6, Ex. 113).

10 In support of its objections, Keating has not pointed to a single case where,
 11 absent a court ordered deadline, an expert report was considered late where it was
 12 served before, or even on the last day of discovery. Keating’s cited authorities are
 13 easily distinguishable because in each, the proffered expert report was served *after*
 14 a court-ordered deadline. *See Wong v. Regents of Univ. of California*, 410 F.3d
 15 1052, 1058 (9th Cir. 2005) (expert reports excluded as untimely because court
 16 ordered counsel to disclose the names of any experts they proposed to offer at trial
 17 “not later than 45 days before the close of discovery”); *Jarritos, Inc. v. Reyes*, 345
 18 F. App’x 215, 217 (9th Cir. 2009) (expert reports excluded as untimely pursuant to
 19 specific court order setting deadline to disclose expert witnesses).

20 That the Court denied Glidewell’s *Ex Parte* Application to Amend the
 21 Scheduling Order on November 9, 2012 (Dkt. #74), is irrelevant to whether
 22 Glidewell complied with the Court’s original Scheduling Order. The issue is
 23 whether Glidewell made its disclosures on or before the close of discovery. Since
 24 discovery closed on October 29, the disclosures were timely. *See Nuance*
 25 *Communications, Inc. v. ABBYY Software House*, C 08-02912 JSW MEJ, 2012 WL
 26 2838431 (N.D. Cal. July 10, 2012) (denying motion to strike 25 witnesses disclosed
 27 after the close of business on the last day of discovery); *3Com Corp. v. Realtek*
 28 *Semiconductor Corp.*, C 03-2177 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24,

2008) (denying motion in limine to preclude defendant from proffering witnesses first disclosed on the final day of fact discovery because plaintiff never requested defendant's agreement or leave of court to subpoena the third-party witnesses past the discovery cut-off); *Cyntegra, Inc. v. Idexx Laboratories, Inc.*, CV06-4170PSG(CTX), 2007 WL 5193736 (C.D. Cal. Sept. 21, 2007) *aff'd*, *Cyntegra, Inc. v. IDEXX Laboratories, Inc.*, 322 F. App'x 569 (9th Cir. 2009) (finding defendant's service of two expert reports on the last day of discovery timely); *Roe v. Nevada*, 621 F. Supp. 2d 1039, 1060 (D. Nev. 2007) (rejecting defendant's argument that plaintiff's disclosure of various fact witnesses on last day of discovery was untimely because defendant's never sought to re-open discovery and "defendants, until now, gave no indication of their desire to depose these witnesses, and therefore any prejudice is caused by Defendants' own dilatory conduct"); *Russell v. Daiichi-Sankyo, Inc.*, CV 11-34-BLG-CSO, 2012 WL 1805038 (D. Mont. May 17, 2012) (holding disclosure of fact witness made on day of discovery cut-off to be timely).

C. Franklyn's Rebuttal to Boatright's Report is not a Sur-Rebuttal Nor Procedurally Improper²

Boatright's October 15, 2012 report (Dkt. #94, Ex. A) cannot credibly be characterized as a rebuttal report to Franklyn's initial September 15, 2012 report. Boatright does not address Franklyn's initial report until the twenty-second page of her report (Paragraph 61). In the first twenty-two pages of her report, Boatright, among other things, opines on the procedure to be followed in the examination of trademark applications, describes her review of the file history for the BRUXZIR mark, opines on what she thinks the Trademark Examining Attorney should have done in this matter, and describes at length her independent internet research. Boatright's report is not so much a rebuttal to Franklyn's report as it is Boatright's

² Keating does not contend that Franklyn's rebuttal report to Eggleston is a sur-rebuttal report.

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1 initial report that sets forth her opinions regarding genericness and likelihood of
 2 confusion while criticizing the Trademark Examining Attorney. Boatright's report
 3 is not "intended *solely* to contradict or rebut" Franklyn's initial report. Fed. R. Civ.
 4 Proc. 26(a)(2)(D)(ii) (emphasis added). Rather, it is a thinly-veiled opening expert
 5 report, served at a point at which Keating (incorrectly) contends such reports were
 6 untimely. Franklyn's rebuttal report is therefore proper under Rule 26(a)(2)(D)(ii).

7 Even if Franklyn's rebuttal report could properly be characterized as a "sur-
 8 rebuttal," sur-rebuttal reports are not procedurally improper. The Scheduling Order
 9 entered here does not preclude them. Rule 26(a)(2)(C)(ii) is silent on the propriety
 10 of sur-rebuttal reports. Many courts allow sur-rebuttal reports, and some even *insist*
 11 that parties file such reports. *See In re Fleming Cos., Inc., Contract Litigation*,
 12 2000 WL 35612913, at *1 (W.D. Mo. Nov. 30, 2000) (agreeing that Rule 26
 13 permits sur-rebuttal reports); *In re Cardizem CD Antitrust Litig.*, 2000 U.S. Dist.
 14 LEXIS 18839, at *6 (E.D. Mich. Oct. 25, 2000) (granting request to submit sur-
 15 rebuttal expert report); *TiVo Inc. v. EchoStar Communs. Corp.*, 2006 U.S. Dist.
 16 LEXIS 97135, at *4 (E.D. Tex. April 3, 2006) (holding that even if the scheduling
 17 order did not provide for the service of sur-rebuttal reports, plaintiff should have
 18 filed one in accordance with Rule 26(a)(2)(C)(ii)). Keating nevertheless claims that
 19 sur-rebuttals are "procedurally disfavored." But in the two cases Keating cites to
 20 support its proposition, the sur-rebuttal testimony was excluded because it was
 21 *cumulative* and repeated the initial testimony, not because of procedural
 22 impropriety. *See United States v. McCollum*, 732 F.2d 1419,1426 (9th Cir. 1984)
 23 (determining that, in a criminal conviction of attempted bank robbery, the district
 24 court acted within its discretion by excluding expert on sur-rebuttal because "the
 25 testimony would have been cumulative" and "the same" as the initial testimony);
 26 *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 757 F. Supp. 1088, 1096 (S.D.
 27 Cal. 1990) (excluding defendant's sur-rebuttal testimony because it "was simply
 28 seeking to repeat testimony already presented in [defendant's] case in chief.").

1 Unlike *McCollum* and *Brooktree Corp.*, Franklyn's rebuttal report to Boatright is
 2 neither cumulative nor a repeat of his initial report, but a direct response to the
 3 numerous new issues and evidence contained in Boatright's report.

4 **D. Even if the Content of Franklyn's Rebuttal Report was Untimely**
 5 **Disclosed, Which It Was Not, Any Delay Was Harmless and**
 6 **Franklyn's Testimony Should Not Be Excluded**

7 Even if Franklyn's rebuttal reports had been disclosed after the discovery
 8 cutoff (which they were not), this does not automatically give rise to the exclusion
 9 of Franklyn's testimony that is based on his rebuttal reports.³ Rather, under Rule
 10 37, a party may still use the information or witness if the late disclosure was
 11 "substantially justified" or "harmless." Fed. R. Civ. P. 37(c)(1); *see also* Fed. R.
 12 Civ. P. 37(c)(1) committee notes 1993 ("[L]imiting the automatic sanction to
 13 violations without substantial justification, coupled with the exception for
 14 violations that are harmless, is needed to avoid unduly harsh penalties in a variety
 15 of situations.") (internal quotations omitted).

16 In determining whether to preclude introduction of evidence pursuant to
 17 FRCP 37, courts consider "(1) the surprise to the party against whom the evidence
 18 would be offered; (2) the ability of that party to cure the surprise; (3) the extent to
 19 which allowing the evidence would disrupt the trial; (4) the importance of the
 20 evidence, and (5) the nondisclosing party's explanation for its failure to disclose the
 21 evidence." *Dey, L.P v. Ivax Pharm., Inc.*, 233 F.R.D. 567, 571 (C.D. Cal. 2005)
 22 (applying factors and declining to preclude late produced evidence); *Katz v. Cont'l*
 23 *Airlines, Inc. (In re Katz Interactive Call Processing Patent Litig.)*, 2009 U.S. Dist.
 24 LEXIS 129933 (C.D. Cal. July 2, 2009). Considering the totality of the
 25 circumstances, even assuming Glidewell's disclosure of the Franklyn rebuttal
 26 reports was untimely, the Court should overrule Keating's objections that it exclude

27
 28 ³ It bears repeating that Keating's timeliness objection, to which Glidewell contests,
 only applies to Paragraphs 55-71 of Franklyn's Declaration.

1 certain portions of Franklyn's Declaration that rely on the rebuttal reports for the
2 reasons set forth below.

3 **1. There is No Real Prejudice or Surprise to Keating and**
4 **Keating had the Opportunity to Cure any Purported**
5 **Prejudice or Surprise**

6 Prejudice does not exist simply because a party has the burden of dealing
7 with additional information or witnesses. *See Garvey v. Kmart Corp.*, 2012 U.S.
8 Dist. LEXIS 160006, at *3 (N.D. Cal. Nov. 6, 2012) (denying a motion to exclude
9 the defendant's fact witness from testifying even though the witness was disclosed
10 after the discovery deadline because the plaintiff declined the opportunity to depose
11 the witness).

12 While a delay, without more, cannot qualify as prejudicial, Keating has not
13 articulated the basis for any perceived prejudice it has suffered as a result of shorter
14 notice of Franklyn's interview with the dentist witnesses. Keating does not even
15 argue that it had insufficient time to digest the content of Franklyn's rebuttal reports
16 or Franklyn's Declaration. Nor could it; the declaration was timely served with
17 Glidewell's motions for partial summary judgment on November 19, 2012 (Dkt.#
18 90, Ex. O), and Keating was able to prepare its oppositions to the motions as well
19 as objections to the declaration and timely file them on November 26, 2012. (Dkt.#
20 123.)

21 Even assuming Franklyn's rebuttal reports were untimely and surprised
22 Keating, Keating could have tried to take a further deposition of Franklyn. After its
23 disclosure, Glidewell offered Franklyn again for deposition. (Dkt. #142, ¶ 8, Ex.
24 115) Keating declined the offer. (*Id.*) Ironically, Glidewell itself sought to extend
25 the discovery cut-off to allow for further discovery and, rather than agree so that
26 Keating itself could get the additional discovery it wanted, Keating opposed the
27 request. (Dkt# 71.) Keating had three weeks between Franklyn's rebuttal reports
28 and the date for filing summary judgment motions in which to depose Franklyn,

1 which it refused.

2 If Keating is in fact prejudiced by Franklyn's rebuttal reports served on the
3 last day of discovery, it is prejudice that Keating manufactured. *Semtech Corp. v.*
4 *Royal Ins. Co. of Am.*, CV 03-2460-GAF PJWX, 2005 WL 6192906 (C.D. Cal.
5 Sept. 8, 2005) (late disclosed supplemental expert report not excluded under Rule
6 37 because the "harm would not warrant the extreme sanction of exclusion" and
7 any potential harm could be cured by allowing a deposition of the expert);
8 *Galentine v. Holland Am. Line-Westours, Inc.*, 333 F. Supp. 2d 991, 994 (W.D.
9 Wash. 2004) (refusing to exclude expert report served eleven days past the deadline
10 because "the potential prejudice that Defendant claims it will suffer is not so severe
11 as to warrant exclusion, especially given the possibility of ameliorating that
12 prejudice [through limited discovery and a deposition of the expert]"); *see Garvey*
13 *v. Kmart Corp.*, 2012 U.S. Dist. LEXIS 160006, at *3 (N.D. Cal. 2012) (denying a
14 motion to exclude fact witness disclosed after the discovery deadline, noting that
15 movant had declined to depose the witness); *3Com Corp. v. Realtek Semiconductor*
16 *Corp.*, C 03-2177 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24, 2008) (denying
17 motion in limine to exclude third-party witnesses disclosed on last day of fact
18 discovery because movant never sought agreement or leave of court to subpoena
19 witnesses after discovery cut-off); *cf. Roe v. Nevada*, 621 F. Supp. 2d 1039, 1060
20 (D. Nev. 2007) (rejecting defendant's argument that disclosure of fact witnesses on
21 last day of discovery was untimely, and noting that "Defendants have sat on their
22 rights to bring any motion to reopen discovery on account of Plaintiffs' last-minute
23 disclosure.... [A]ny prejudice is caused by Defendants' own dilatory conduct.").

24 **2. The Content of Franklyn's Rebuttal Reports Will Not**
25 **Disrupt the Trial**

26 The third factor, disruption to the trial, also weighs in favor of Glidewell.
27 Allowing Franklyn to proffer testimony related to his rebuttal reports on summary
28 judgment will not disrupt the trial, as it is approximately three months away, and it

will not disrupt the summary judgment proceedings. *Kanawha-Gauley Coal & Coke Co. v. Pittston Minerals Group, Inc.*, 2:09-CV-01278, 2011 WL 320909 (S.D.W. Va. Jan. 28, 2011) (third factor inapplicable where supplemental expert report served after expert disclosure deadline but still four months before trial); *see Dey, L.P. v. Ivax Pharmaceuticals, Inc.*, 233 F.R.D. 567, 572 (C.D. Cal. 2005) (court found that third factor weighed against preclusion of evidence at pre-trial stage because the evidence went to issues set forth in defendant's counterclaim and likely would be relevant and probative). As mentioned above, Keating was able to review and respond to the declaration for its response to Glidewell's motions for partial summary judgment, and has still more time to strategize regarding its response to this evidence before trial. The parties need not even meet for their FRCP 16 meeting of counsel (before the pre-trial conference) until December 19, 2012. (C.D. Local Rule 16-2)

3. The Disputed Portion of Franklyn's Testimony is Important

The disputed portions of Franklyn's testimony (Paragraphs 55-71) is important. Franklyn testifies how his interviews with the dentist witnesses corroborate his opinions as to the generic terms for solid zirconia crowns, the strength of Glidewell's BruxZir mark, and the overlap in markets and likelihood of confusion between Glidewell's BruxZir mark and Keating's KDZ Bruxer mark. Franklyn's testimony relates to issues of genericness and confusion. The issues and topics to which Franklyn provides testimony are not new to the parties. *See Tuna Processors, Inc. v. Haw. Int'l Seafood, Inc.*, No. Civ. 05-517 BMK, 2007 WL 433547, *2 (D.Haw. Feb. 5, 2007) ("The failure to properly disclose is harmless where there is no prejudice to the opposing party. There is generally no prejudice where the untimely evidence does not raise any new issues in the case").

4. Glidewell Timely Served Franklyn's Rebuttal Reports in Response to Boatright's and Dr. Eggleston's Reports

Glidewell served Franklyn's rebuttal to Dr. Eggleston's report and

1 Boatright's so-called rebuttal report within the deadline permitted under Rule
2 26(a)(2)(D)(ii) and, in any event, only two weeks after receiving the reports.

3 A review of the factors above demonstrates that any late disclosure by
4 Glidewell of Dr. Goldstein was harmless. Late disclosed evidence that is harmless
5 should not be excluded. *Estate of Gonzalez v. Hickman*, 05-00660 MMM (RCX),
6 2007 WL 3237635 (C.D. Cal. June 28, 2007) (untimely disclosure of three expert
7 reports justified and harmless and not excluded); *Tuna Processors, Inc., supra*, No.
8 Civ. 05-517 BMK, 2007 WL 433547, *2 (D.Haw. Feb. 5, 2007) ("The failure to
9 properly disclose is harmless where there is no prejudice to the opposing party.
10 There is generally no prejudice where the untimely evidence does not raise any new
11 issues in the case"); *Crosspointe, LLC v. Integrated Computing, Inc.*, 2004 WL
12 5487401, at *1 (M.D. Fla. Aug. 18, 2004) (court allowed belated disclosure of
13 supplemental expert report because the opposing party did not show "with
14 sufficient specificity how they are prejudiced").

15 **5. Glidewell Timely Served Franklyn's Rebuttal Report in** 16 **Response to Boatright's Report**

17 The content of Franklyn's rebuttal report was not disclosed late. But even if
18 the Court concludes that it was untimely, a review of the factors above
19 demonstrates that any late disclosure by Glidewell of the content of Franklyn's
20 testimony was harmless. Late disclosed evidence that is harmless should not be
21 excluded. *Estate of Gonzalez v. Hickman*, 05-00660 MMM (RCX), 2007 WL
22 3237635 (C.D. Cal. June 28, 2007) (untimely disclosure of three expert reports
23 justified and harmless and not excluded); *Tuna Processors, Inc., supra*, No. Civ.
24 05-517 BMK, 2007 WL 433547, *2 (D. Haw. , 2007) ("The failure to properly
25 disclose is harmless where there is no prejudice to the opposing party. There is
26 generally no prejudice where the untimely evidence does not raise any new issues
27 in the case."); *Crosspointe, LLC v. Integrated Computing, Inc.*, 2004 WL 5487401,
28 at *1 (M.D. Fla. Aug. 18, 2004) (court allowed belated disclosure of supplemental

expert report because the opposing party did not show “with sufficient specificity how they are prejudiced”).

E. Franklyn’s Testimony is Proper

1. Franklyn Does Not Offer Improper Legal Opinions

Citing three cases involving *copyright law*, and pointing out the fact that Franklyn is not a dental expert (indeed, Franklyn does not profess to be a dental expert), Keating argues that Franklyn’s testimony regarding genericness of the BruxZir mark, the strength of the BruxZir mark and the risk of consumer confusion constitutes improper legal opinion. This is not so.

Engaging experts (usually attorneys) to proffer opinion testimony concerning such matters as the strength of a mark, similarity between marks, the potential for customer confusion, and other specialized issues pertinent to a trademark case is a commonly accepted practice. *See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.*, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 252 F.3d 1010, 1012 (8th Cir. 2001) (attorney expert testified as to the distinction of a suggestive mark versus a descriptive mark, and gave his opinion that the mark in question was merely descriptive); *Waco Intl, Inc. v. KHK Scaffolding Houston Inc.*, 278 F.3d 523, 533 (5th Cir. 2002) (holding that district court did not err by permitting attorney to testify despite arguments that attorney was testifying as to matters of law); *Gander Mountain Co. v. Cabela's, Inc.*, 540 F.3d 827, 832 (8th Cir. 2008) (allowing expert testimony from both parties regarding customary content of perpetual trademark licenses); *Xtreme Lashes, LLC v. Xtended Lashes, LLC*, 576 F.3d 221, 232 (5th Cir. 2009) (expert testimony considered in determining whether EXTEND YOUR

BEAUTY was descriptive or suggestive mark); *The Fresh Market v. Marsh Supermarkets, Inc.*, 2005 WL 2154677 at *3 (N.D. Ind. Sept. 7, 2005) (plaintiff moved to strike expert testimony because it opined on legal question as to likelihood of confusion; district court denied because professor was qualified to testify about consumer habits); *Tenneco Auto. Operating Co., Inc. v. Kingdom Auto Parts*, 2010 WL 4365580 at *10-12 (6th Cir. Oct. 28, 2010) (finding trademark attorney's opinion as an expert persuasive as to whether product numbers were protectable marks).

Thus, Keating's legal conclusion objections are meritless as they involve proper expert testimony. Indeed, each of the cases that Keating cites is inapplicable because it disallowed expert testimony on "pure issues of law – that is whether a particular item is copyrightable." *See Ticketmaster Corp. v. Tickets.com, Inc.*, CV 99-07654HLH (VBKX), 2003 WL 25781901, at *1 (C.D. Cal. Feb. 10, 2003) (only excluded the expert's legal conclusions that were "within the sole province of the court" and items "solely directed toward the dismissed claims," but admitted a law professor's testimony on the possibility of confusion because the professor's "years of background and experience with the internet qualify him to describe the workings of the items at issue in this case"); *Jonathan Browning, Inc. v. Venetian Casino Resort LLC*, 2009 U.S. Dist. LEXIS 57665, at *2 (N.D. Cal. June 18, 2009); *Religious Tech. Ctr. v. Netcom On-Line Commc'n Services, Inc.*, C-95-20091 RMW, 1997 WL 34605244 (N.D. Cal. Jan. 6, 1997) (excluding inadmissible declarations that were only "reciting case law and legal conclusions")

Finally, it bears noting that Keating itself submits a declaration from Boatright that attaches her so-called rebuttal report wherein Boatright opines that, among other things, the BruxZir mark is generic and weak and that the mark should

1 have been denied registration by the PTO. (Dkt. #94, Ex. A.)⁴ Certainly if portions
 2 of Franklyn's testimony are excluded as improper legal conclusions, so too should
 3 Boatright's testimony. However, the correct outcome here is to reject Keating's
 4 objection that Prof. Franklyn's testimony constitutes an improper legal conclusion.

5 **2. That Franklyn Is a Law Professor, Not a Trademark**
 6 **Practitioner, Is Irrelevant**

7 Keating makes much of the fact that Professor Franklyn is not a trademark
 8 practitioner. Why this should matter is not clear. This is not a TTAB proceeding,
 9 and the registration of the mark is not at issue. Keating relies on *Charter National*
 10 *Bank & Trust* for the proposition that a trademark law professor, lacking practical
 11 experience defending or prosecuting trademarks, is an improper expert. However,
 12 in that case, the expert at issue was not a professor in trademark law, had never
 13 published any material on trademark law, lacked practical work experience
 14 regarding trademark registrations, and had never drafted, defended or prosecuted a
 15 trademark registration application. *Charter Nat. Bank & Trust v. Charter One Fin.,*
 16 *Inc.*, 01 C 0905, 2001 WL 1035721 (N.D. Ill. Sept. 4, 2001). The court found, that
 17 "[g]iven that none of his published work involves trademark law and that trademark
 18 law only comprises a small subset of larger topics which he teaches, we cannot find
 19 Professor Lichtman qualified as an expert." *Id.* The court went on to explain that
 20 the professor was not currently qualified to testify as an expert on trademark law,
 21 leaving open the possibility that he could later become qualified, especially given
 22 the fact that he was, at the time of the case, researching a project with a focus in
 23 trademark law. *Id.* The court did not, as Keating suggests, unequivocally state that

24 ⁴ It should be noted that Keating's attempt to introduce Boatright's expert report
 25 into evidence should be rejected. The attached expert report is not signed under
 26 penalty of perjury. Accordingly, it is inadmissible hearsay. FRE 801, 802; *Harris*
 27 *v. Extendicare Homes, Inc.*, 829 F. Supp. 2d 1023, 1027 (W.D. Wash. 2011)
 28 ("[C]ourts in this circuit have routinely held that . . . unsworn expert reports are not
 admissible to support or oppose summary judgment."); *King Tuna, Inc. v. Anova*
Food, Inc., 2009 WL 650732 (C.D. Cal. 2009) ("It is well-settled that under Fed. R.
 Civ. P. 56(e), unsworn expert reports are not admissible to support or oppose
 summary judgment.").

1 an expert must have practical experience, such as drafting an application,
 2 defending, or prosecuting a trademark. *Id.* Nor did the court imply that teaching,
 3 publishing, and being well-read in the field, is insufficient, only that it was
 4 insufficient for the expert at issue because he was not a trademark law professor.
 5 *Id.*

6 Indeed, federal courts allow law professors to serve as experts in trademark
 7 infringement issues. *See e.g., Adobe Sys. Inc. v. One Stop Micro, Inc.*, 84 F. Supp.
 8 2d 1086, 1091 (N.D. Cal. 2000) (Raymond T. Nimmer, a professor of law at the
 9 University of Houston, serves as an expert in a suit involving copyright and
 10 trademark infringement); *Fancaster, Inc. v. Comcast Corp.*, 832 F. Supp. 2d 380,
 11 408 (D.N.J. 2011) (law professor allowed to testify on “the system of Internet
 12 domain names” in a trademark dispute); *Children’s Med. Center v. Columbia*
 13 *Hosp.*, No. 3-04-2436-BD, 2006 U.S. Dist. LEXIS 9752, at *5 (N.D. Tex. March
 14 10, 2006) (denying challenge to trademark law professor’s opinion on the strength
 15 of a mark based on the results of a trademark search report obtained by the
 16 plaintiffs because “[a]n expert may base an opinion on facts or data of a type
 17 reasonably relied upon by experts in the particular field in forming opinions or
 18 inferences upon the subject” and the expert stated that search reports are “generally
 19 relied upon by trademark practitioners when advising clients as to the availability of
 20 marks for use and registration”).

21 **3. Franklyn Relies on Proper Methodologies and Analysis to**
 22 **Support His Expert Opinions**

23 Keating’s claim that Franklyn’s methodology is unreliable and incorrect is
 24 two-fold: (1) Keating attacks Franklyn’s PTO search regarding genericness; and (2)
 25 Keating attacks Franklyn’s dentist interviews on the ground that it constitutes
 26 improper survey evidence. Keating is wrong on both points.

27 First, the types of evidence upon which the Court may look to evaluate
 28 Keating’s allegation that the BruxZir mark is generic are not as limited as Keating

implies. They include: “(1) dictionary definitions; (2) generic use of the term by competitors and other persons in the trade; (3) plaintiff’s own generic use; (4) generic use in the media; and (5) consumer surveys.” *See Brandwynne v. Combe Int’l Ltd.*, 74 F. Supp. 2d 364, 381 (S.D.N.Y. 1999). “In addition to these factors, it is necessary to determine whether there are commonly used alternative means to describe the product or service.” *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 305-06 (3d Cir. 1986). More specifically, courts can rely on the type of PTO searches conducted by Franklyn and to which he testifies in his declaration. For example, in *Nietech Corp. v. CBS Data Servs.*, 2004 U.S. Dist. LEXIS 30318, at *41 (N.D. Cal. Mar. 1, 2004), the United States District Court for the Northern District of California denied plaintiffs motion for preliminary injunction. In evaluating the strength of plaintiff’s mark, the Court specifically relied on the “numerous instances of the use of [the mark] in the PTO’s Trademark Electronic Search System (‘TESS’) database as well as numerous listings on the Internet of programs with [similar marks at issue].” *See also Globalaw Ltd. v. Carmon & Carmon Law Office & Globalaw, Inc.*, 452 F. Supp. 2d 1, 36 (D.D.C. 2006) (allowing defendant to use TESS search to argue that the mark was not generic). Further, a trademark applicant must specifically identify the goods and services relevant to the applicant’s potential mark to enable the USPTO to properly classify the goods and services and to properly evaluate likelihood of confusion. 15 U.S.C. § 1052(d); 37 C.F.R. § 2.32(a)(6). Consequently, the absence of an alleged generic term in the goods and services description in the TESS database is relevant to whether a mark is generic.

Second, Glidewell does not contend Franklyn is a survey expert or that the interview that he conducted constitutes survey evidence. Rather, the interviews conducted and detailed in Franklyn’s Declaration provide relevant anecdotal evidence that underlies Franklyn’s opinions regarding the strength of the BruxZir

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mark and the risk of consumer confusion. Indeed, such anecdotal evidence is routinely evaluated in considering both genericness and infringement. *See e.g., Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 554 (S.D.N.Y. 1991) (“Typically, an infringement plaintiff undertakes to prove actual confusion between its and the defendant's product or services in two ways: anecdotal evidence of particular incidents and market research surveys.”); *Fancaster, Inc. v. Comcast Corp.*, 832 F. Supp. 2d 380, 419-20 (D.N.J. 2011) (allowing expert to utilize interviews and press conferences separately from surveys to opine on the strength of the mark at issue); *UGG Holdings, Inc. v. Severn*, CV04-1137-JFW FMOX, 2005 WL 5887187, at *4 (C.D. Cal. Feb. 23, 2005) (assessing anecdotal evidence to determine whether the term “ug boots” has been used generically); *Nora Beverages, Inc. v. Perrier Group of Am., Inc.*, 269 F.3d 114, 123-24 (2d Cir. 2001) (noting that “anecdotal evidence is admissible to establish actual consumer confusion”); *Volkswagen Astiengesellschaft v. Uptown Motors*, 91 CIV. 3447(DLC), 1995 WL 605605, at *2 (S.D.N.Y. May 11, 1995) (“Typically, actual confusion is proven either through anecdotal evidence or surveys.”).

III. CONCLUSION

For the foregoing reasons, Glidewell respectfully requests that the Court overrule Keating’s objections and admit the Franklyn testimony in its entirety for all purposes, including ruling upon the parties’ motions for summary judgment.

Dated: December 3, 2012

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EXHIBIT A

Testimony	Keating's Objection	Glidewell's Response
¶ 12-31	<p>Irrelevant (as to conducting word searches of the goods and services descriptions because absence of a word in the goods and services description cannot be used to determine whether a word is generic) (FRE 402)</p> <p>Improper Expert Methods (as to Franklyn's use of the goods and services searches in determining whether "BruxZir" or "bruxer" are generic terms) (FRE 702)</p>	<p>Franklyn's testimony regarding the secondary TESS searches he conducted is neither irrelevant nor improper. Keating cites no authority to support its objections. Nor could it. Courts may rely on the type of TESS searches conducted by Franklyn that are described in Paragraph 12 through 31 of his declaration. <i>See Nietech Corp. v. CBS Data Servs.</i>, 2004 U.S. Dist. LEXIS 30318, at *41 (N.D. Cal. Mar. 1, 2004) (specifically relying on the "numerous instances of the use of [the mark] in the PTO's Trademark Electronic Search System ('TESS') database as well as numerous listings on the Internet of programs with [similar marks at issue]"); <i>Globalaw Ltd. v. Carmon & Carmon Law Office & Globalaw, Inc.</i>, 452 F. Supp. 2d 1, 36 (D.D.C. 2006) (allowing defendant to use TESS search to argue that the mark was not generic.); 15 U.S.C. §1052(d), 37 C.F.R. §2.32(a)(6) (requiring that</p>

Testimony	Keating's Objection	Glidewell's Response
		the trademark applicant must identify the goods and services specifically to provide public notice and to enable the USPTO to classify the goods and services properly and to reach informed judgments concerning likelihood of confusion).
¶ 36	<p>Improper expert opinion, (as to whether BruxZir is generic in the dentistry field, because Franklyn is not an expert in dentistry) (FRE 702).</p> <p>Improper methods for expert analysis (FRE 702) and Insufficient factual foundation (FRE 602) (as to whether BruxZir has become a generic name in the dentistry field because a TESS search of goods and services and an online search for “bruxor/bruxer/bruxzir crowns” are insufficient to reach an opinion that the term is not generic).</p>	<p>Franklyn need not be a dental expert to opine on the genericness of the BruxZir mark. Utilizing attorney experts, including law professors, to opine on the specialized field of trademarks, trademark terms of art and trademark agreements is a commonly accepted practice. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63 (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>similar service mark, and whether the companies were in competition with one another);</p> <p><i>Children's Med. Center v. Columbia Hosp.</i>, No. 3-04-2436-BD, 2006 U.S. Dist. LEXIS 9752, at *5 (N.D. Tex. March 10, 2006). Franklyn may also base his opinion, in part, on the TESS searches he conducted and for which he established an adequate factual foundation at Paragraph 5 of his Declaration. <i>See Nietech Corp. v. CBS Data Servs.</i>, 2004 U.S. Dist. LEXIS 30318, at *41 (N.D. Cal. Mar. 1, 2004) (specifically relying on the “numerous instances of the use of [the mark] in the PTO’s Trademark Electronic Search System (‘TESS’) database as well as numerous listings on the Internet of programs with [similar marks at issue]”);</p> <p><i>Globalaw Ltd. v. Carmon & Carmon Law Office & Globalaw, Inc.</i>, 452 F. Supp. 2d 1, 36 (D.D.C. 2006) (allowing defendant to use TESS search to</p>

Testimony	Keating's Objection	Glidewell's Response
		argue that the mark was not generic.); 15 U.S.C. §1052(d), 37 C.F.R. §2.32(a)(6) (requiring that the trademark applicant must identify the goods and services specifically to provide public notice and to enable the USPTO to classify the goods and services properly and to reach informed judgments concerning likelihood of confusion).
¶ 43	<p>Improper speculation (FRE 602 a witness may not testify to a matter unless evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.”) and</p> <p>Improper Expert Legal Opinion (<i>Brodie</i>, 858 F.2d at 497) (as to whether the only individuals who are attempting to refer to an all-zirconia crown or bridge are those that have a vested interest in free riding or are selling BruxZir-made materials)</p> <p>Improper speculation and improper expert</p>	<p>Franklyn's testimony is based on internet searches and TESS searches that he conducted and that he details in his declaration at Paragraphs 5 through 35. Franklyn has personal knowledge about the matters to which he testified. Fed. R. Evid. 602. Further, Franklyn does not offer any legal conclusions in this statement. Keating's final objection as to improper speculation and improper expert opinion is incomplete. Glidewell has no way of knowing what testimony the objection specifically targets, nor the basis for the</p>

Testimony	Keating's Objection	Glidewell's Response
	opinion (as to whether	objection, and therefore does not respond to the partial objection.
¶ 47	<p>Irrelevant (FRE 402) (as to whether Google mark is strong) Insufficient factual foundation (as to whether dentists and dental labs know Glidewell's products through its BruxZir trademarks) (FRE 602).</p> <p>Lack of personal knowledge (as to amount Glidewell has spent on advertising, as to Glidewell's dominance in relevant markets, as to whether BruxZir is well known by dentists) (FRE 602).</p>	<p>Franklyn's statement regarding Google supports his position that a mark's strength is based, in part, on recognition by consumers in a particular market. It is relevant. Fed. R. Evid. 402.</p> <p>Keating's foundational objection is baseless.</p> <p>Franklyn's opinion is based on a myriad of evidence, all of which is set forth throughout his declaration, Paragraphs 4, 5, 43, 44, and 55-69 in particular.</p> <p>Keating's personal knowledge objection is puzzling. Franklyn does not profess to have personal knowledge of Glidewell's advertising expenditures. Rather, he bases his statement on discovery responses and conversations with Jim Shuck, Glidewell's Vice President of Sales and Marketing. Franklyn may rely on discovery responses and Shuck's statements to support his</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>opinions, because a statement regarding advertising expenditures is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160, 1169 (9th Cir. 2000) (reliability based on training, experience, and personal knowledge).</p>
¶ 48	<p>Information not helpful to jury (as to whether Franklyn believes the goods to be in the same market; jury does not need expert for that)</p>	<p>An expert such as Franklyn can competently testify that the parties to a trademark action sell goods and services in the same or highly overlapping markets. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63 (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to, among other things: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies</p>

Testimony	Keating's Objection	Glidewell's Response
		were in competition with one another).
¶ 49	<p>Insufficient factual foundation (as to whether dentists know the product as a BruxZir brand crown, because no evidence cited and Franklyn is not an expert within the dental field) (FRE 602).</p> <p>Improper expert opinion (FRE 702), improper speculation (FRE 602), and irrelevance (FRE 402) (as to whether one would have thought that Keating would call its product KDA Bruxer).</p> <p>Improper new evidence (as to discussions with dentists, because such witnesses were not disclosed during discovery period) (FRCP 37(c)).</p> <p>Conclusion supported by inadmissible evidence (as to whether there is a significant risk that Keating will be able to trade on Glidewell's good will and fame, because its support stems from inadmissible witness interviews).</p> <p>Insufficient factual foundation (as to whether there is a significant risk that Keating will be able</p>	<p>Keating's foundational objection is baseless.</p> <p>Franklyn's opinion is based on a myriad of evidence, all of which is set forth throughout his declaration, Paragraphs 4, 5, 43, 44, and 55-69 in particular.</p> <p>Franklyn's statement regarding Keating's choice to call its product KDZ Bruxer versus KDA Bruxer is relevant and the subject of appropriate expert testimony as it directly relates to likelihood of confusion. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63 (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to, among other things: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a</p>

Testimony	Keating's Objection	Glidewell's Response
	to trade on good will and fame of Glidewell) (FRE 602).	<p>similar service mark, and whether the companies were in competition with one another).</p> <p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal report to Boatright, which was timely served under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and before the discovery period closed under the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).]</p> <p>Franklyn may rely on these dentist interviews, for which he has established an adequate factual foundation, even if the dentist interviews were inadmissible (which they are not), to support his opinions, because a statement regarding Glidewell's recognition and good will in the market is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160,</p>

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Testimony	Keating's Objection	Glidewell's Response
		1169 (9th Cir. 2000) (reliability based on training, experience, and personal knowledge).
¶ 50	<p>Irrelevant (as to whether major competitors use Bruxer for crowns or for material to make the crowns) (FRE 402).</p> <p>Improper speculation (FRE 602) and insufficient factual foundation (as to whether there is no need for Keating to use BruxZir to compete because Franklyn is not an expert in dentistry and has not submitted admissible survey evidence from those in the dental field to support this conclusion).</p>	<p>Franklyn's statement that the other major competitors in this field do not use bruxer or any variation of the word "brux" as part of their marks for solid zirconia crowns or for material used to make such crowns is relevant to determine whether the BruxZir mark is generic. Fed. R. Evid. 402.</p> <p>Keating's foundational objection is baseless. Franklyn's opinion is based on a myriad of evidence, all of which is set forth throughout his declaration, Paragraphs 4, 5, 43, 44, and 55-69 in particular.</p> <p>Franklyn's statement is not speculation, but an opinion rationally based on the documents he reviewed, the internet searches and PTO searches he conducted, and the individuals he spoke with in connection with his engagement.</p>

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Testimony	Keating's Objection	Glidewell's Response
¶ 51	Improper legal conclusion (as to legal standard of counterclaim) (FRE 702, and <i>Nationwide Trans. Fin.</i> , 523 F.3d at 1058 (instructing as to applicable law is the “distinct and exclusive province of the court”) (citations omitted).	Franklyn can opine on issues of genericness in an infringement action. His statements are not improper legal conclusions. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i> , 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>B & B Hardware, Inc. v. Hargis Industries, Inc.</i> , 252 F.3d 1010, 1012 (8th Cir. 2001) (attorney expert testified as to the distinction of a suggestive mark versus a descriptive mark, and gave his opinion that the mark in question was merely descriptive).

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Testimony	Keating's Objection	Glidewell's Response
¶ 52	<p>Lack of personal knowledge and improper speculation (as to when Keating entered the dental crown market) (FRE 602)</p> <p>Insufficient factual foundation (Franklyn does not provide what evidence he relies on in support of his "understanding" of when Keating entered the market) (FRE 602).</p>	<p>Keating's personal knowledge objection is puzzling. Franklyn does not profess to have personal knowledge of when Glidewell entered the market. Rather, he bases his statement on discovery responses and conversations with Glidewell employees. Franklyn may rely on discovery responses and Shuck's statements to support his opinions, because a statement regarding entry into the market is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160, 1169 (9th Cir. 2000) (reliability based on training, experience, and personal knowledge).</p>
¶ 53	<p>Improper legal conclusion (FRE 702) (as to whether evidence is proper or not)</p>	<p>Franklyn can opine on issues of genericness in an infringement action. His statements are not improper legal conclusions. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>B & B Hardware, Inc. v. Hargis Industries, Inc.</i>, 252 F.3d 1010, 1012 (8th Cir. 2001) (attorney expert testified as to the distinction of a suggestive mark versus a descriptive mark, and gave his opinion that the mark in question was merely descriptive).</p>
¶ 55	Improper new evidence (as to interviews with dentists, the conclusions resulting therefrom, and as to Dr. DiTolla's credentials, because such witnesses and the interview evidence were not disclosed during discovery period) (FRCP 37(c))	Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period

Testimony	Keating's Objection	Glidewell's Response
	<p>Inadmissible Hearsay (FRE 802) (Franklyn offers DiTolla's statements for its truth)</p> <p>Lack of Personal Knowledge (FRE 602) (as to whether "bruxer" is widely used in the dental industry)</p>	<p>closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn may rely on these dentist interviews, even if the dentist interviews were inadmissible, to support his opinions, because a statement regarding dental terms is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160, 1169 (9th Cir. 2000) (reliability based on</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>training, experience, and personal knowledge). Franklyn does not offer the Dr. DiTolla's statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's personal knowledge objection makes no sense. Franklyn merely repeats Dr. DiTolla's statement regarding the lack of wide use of the term "bruxer"; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 56	Improper new evidence (as to all information related to Dr. Christianson and any conclusions resulting therefrom because not disclosed during discovery period) (FRCP 37(c)).	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ.</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p>
¶ 57	<p>Inadmissible Hearsay (Franklyn improperly Dr. Christianson's statements for its truth) (FRE 802) Lack of Personal Knowledge (Franklyn relies on Dr. Christianson's statements as to whether "BruxZir" is well known and widely recognized, as to the past and present generic names for zirconia crowns, and as to the use, qualities and characteristics of BruxZir zirconium crowns) (FRE 602).</p>	<p>Franklyn does not offer the Dr. Christianson's statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Franklyn may rely on these dentist interviews, even if the dentist interviews were inadmissible, to support his opinions, because a statement regarding the recognition of a particular mark in</p>

Testimony	Keating's Objection	Glidewell's Response
	<p>Improper legal conclusion (as to whether BruxZir is generic) (FRE 702)</p> <p>Improper expert testimony (Franklyn is not an expert in the dental field) (FRE 702)</p>	<p>the industry is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160, 1169 (9th Cir. 2000) (reliability based on training, experience, and personal knowledge). Keating's personal knowledge objection makes no sense. Franklyn merely repeats Dr. DiTolla's statement regarding the lack of wide use of the term "bruxer"; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 58	<p>Inadmissible Hearsay (as to Dr. Christianson's statements) (FRE 802)</p> <p>Improper legal conclusion (as to whether there is "an invasion" of Glidewell's mark, as to whether there is a likelihood of confusion)(FRE 702)</p> <p>Lack of personal knowledge (FRE 602) and Improper lay witness opinion (FRE 701) (as to whether Glidewell initiated the wide use of full</p>	<p>Franklyn does not offer the Dr. Christianson's statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's legal conclusion, personal knowledge, lay witness opinion and speculation objections make no sense. Franklyn merely repeats Dr.</p>

Testimony	Keating's Objection	Glidewell's Response
	<p>zirconia crowns and as to whether it is well known for its product).</p> <p>Improper speculation (FRE 602) (as to whether there is "an invasion" of the Glidewell mark, as to likelihood of confusion, as to whether other companies feel the need to do "this", as to the risk of counterfeit products; as to whether Glidewell initiated the wide use of full zirconia crowns and is well known under the BruxZir name).</p> <p>Lacks foundation (FRE 602) (as to the entire paragraph)</p>	<p>Christianson's statements regarding the relationship between Glidewell's mark and the KDZ Bruxer mark; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 59	<p>Improper new evidence (as to Dr. Goldstein) (FRCP 37(c))</p> <p>Inadmissible Hearsay (as to Dr. Goldstein's statements) (FRE 802)</p> <p>Improper speculation and lacks foundation (as to whether BruxZir is the most popular general crown) (FRE 602).</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ.</p>

Testimony	Keating's Objection	Glidewell's Response
	<p>Lack of Personal Knowledge (Franklyn relies entirely on Dr. Goldstein's statements) (FRE 602)</p>	<p>Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn does not offer the Dr. Goldstein's statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's speculation, foundation and personal knowledge objections make no sense. Franklyn merely repeats Dr. Goldstein's statements regarding Glidewell's products; and not for the</p>

Testimony	Keating's Objection	Glidewell's Response
		truth of the matter asserted, but to elucidate the bases for his opinions.
¶ 60	<p>Improper new evidence (as to Dr. Goldstein's assertions) (FRCP 37(c))</p> <p>Inadmissible Hearsay (as to Dr. Goldstein's statements) (FRE 802)</p> <p>Lack of Personal Knowledge (Franklyn relies entirely on Dr. Goldstein's statements) (FRE 602)</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>Franklyn does not offer the Dr. Goldstein's statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's personal knowledge objection makes no sense. Franklyn merely repeats Dr. Goldstein's statements regarding Glidewell's mark; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 61	<p>Improper new evidence (as to Dr. Goldstein's statements) (FRCP 37(c))</p> <p>Inadmissible Hearsay (as to Dr. Goldstein's statements) (FRE 802)</p> <p>Lack of Personal Knowledge (Franklyn relies entirely on Dr. Goldstein's statements) (FRE 602)</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn does not offer the Dr. Goldstein's statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's personal knowledge objection makes no sense. Franklyn merely repeats Dr. Goldstein's statements regarding certain dental terms; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>

Testimony	Keating's Objection	Glidewell's Response
¶ 62	<p>Improper new evidence (as to Dr. Goldstein's statements and credentials) (FRCP 37(1))</p> <p>Inadmissible Hearsay (as to Dr. Goldstein's statements) (FRE 802)</p> <p>Improper Speculation (as to whether Dr. Goldstein would have heard the term "bruxer") (FRE 602)</p> <p>Lack of Personal Knowledge (Franklyn relies entirely on Dr. Goldstein's statements) (FRE 602)</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn does not offer the Dr. Goldstein's statements for the truth of the matters asserted,</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's speculation and personal knowledge objections make no sense. Franklyn merely repeats Dr. Goldstein's statements regarding certain dental terms; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 63	<p>Improper new evidence (as to the identity of Drs. Fanning, Cianciulli, Michaels, and McNicholas and as to the interviews conducted with the dentists because the witnesses and the interview evidence were not disclosed during discovery period) (FRCP 37(1))</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely</p>

Testimony	Keating's Objection	Glidewell's Response
		and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.
¶ 64	<p>Improper new evidence (as to the opinions, assertions of fact and conclusions of these dentists) (FRCP 37(1))</p> <p>Inadmissible Hearsay (as to the statements and conclusions made by these dentists) (FRE 802)</p> <p>Lack of Personal Knowledge (Franklyn relies entirely on the statements from the dentists) (FRE 602)</p> <p>Improper expert testimony (as to the generic terms for full zirconia crown, because Franklyn is not an expert in dentistry) (FRE 702)</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn does not offer the dentists' statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's personal knowledge objection make no sense. Franklyn merely summarizes statements made by the dentists Franklyn interviewed; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p> <p>Franklyn need not be a dental expert to opine on the generic terms for full zirconia crown.</p> <p>Utilizing attorney experts, including law</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>professors, to proffer opinion testimony concerning such matters as the strength of a mark, similarity between marks, the potential for customer confusion, and other specialized issues pertinent to a trademark case is a commonly accepted practice. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>Children's Med. Center v. Columbia Hosp.</i>, No. 3-04-2436-BD, 2006 U.S. Dist. LEXIS 9752, at *5 (N.D. Tex. March 10, 2006).</p>

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Testimony	Keating's Objection	Glidewell's Response
¶ 65	<p>Improper new evidence (as to the opinions, assertions of fact and conclusions of the dentists) (FRCP 37(1))</p> <p>Inadmissible Hearsay (as to the dentists' statements and conclusions) (FRE 802)</p> <p>Lack of Personal Knowledge (Franklyn relies entirely on the dentists' statements) (FRE 602)</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn does not offer the dentists' statements for the truth of the matters asserted, but rather to</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's personal knowledge objection make no sense. Franklyn merely summarizes statements made by the dentists Franklyn interviewed; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 66	<p>Improper new evidence (as to the dentists' opinions, assertions of fact and conclusions) (FRCP 37(1))</p> <p>Inadmissible Hearsay (as to the dentists' statements and conclusions) (FRE 802)</p> <p>Lack of Personal Knowledge (Franklyn relies entirely on the dentists' statements) (FRE 602)</p> <p>Improper speculation (as to whether the dentists would mistakenly believe that a mark with "bruxer" would be affiliated with or sponsored by</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely</p>

Testimony	Keating's Objection	Glidewell's Response
	Glidewell.) (FRE 602)	<p>and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn does not offer the dentists' statements for the truth of the matters asserted, but rather to elucidate the bases for his opinions. Fed. R. Evid. 801(c); <i>United States v. Kirk</i>, 844 F.2d 660, 663 (9th Cir. 1988).</p> <p>Keating's speculation and personal knowledge objections make no sense. Franklyn merely repeats the dentists' statements regarding the term "bruxer"; and not for the truth of the matter asserted, but to elucidate the bases for his opinions.</p>
¶ 67	Inadmissible lay witness testimony (as to whether	Franklyn can testify as to whether BruxZir,

Testimony	Keating's Objection	Glidewell's Response
	<p>BruxZir, Bruxer or "bruxer" has become generic for a type of dental crown) (FRE 701)</p> <p>Conclusion supported by inadmissible evidence (as to whether BruxZir, Bruxer or "bruxer" has become generic, because it relies on the corroboration of the dentists' inadmissible evidence) (FRCP 56(c)(2); 37(c)(1)).</p>	<p>Bruxer or "bruxer" has become generic for a type of dental crown. Utilizing attorney experts, including law professors, to proffer opinion testimony concerning such matters as the strength of a mark, similarity between marks, the potential for customer confusion, and other specialized issues pertinent to a trademark case is a commonly accepted practice. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another);</p> <p><i>Children's Med. Center v. Columbia Hosp.</i>, No.</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>3-04-2436-BD, 2006 U.S. Dist. LEXIS 9752, at *5 (N.D. Tex. March 10, 2006).</p> <p>Franklyn may rely in part on the dentist interviews he conducted, even if the dentist interviews were inadmissible, to support his opinions, because a statement regarding dental terms is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160, 1169 (9th Cir. 2000) (reliability based on training, experience, and personal knowledge).</p>
¶ 68	Improper expert testimony (as to whether BruxZir or “bruxer” is predominantly seen as generic, because Franklyn is not a dentistry expert) (FRE 702)	<p>Franklyn can testify as to whether BruxZir, Bruxer or “bruxer” has become generic for a type of dental crown. Utilizing attorney experts, including law professors, to proffer opinion testimony concerning such matters as the strength of a mark, similarity between marks, the potential for customer confusion, and other specialized issues pertinent to a trademark case</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>is a commonly accepted practice. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>Children's Med. Center v. Columbia Hosp.</i>, No. 3-04-2436-BD, 2006 U.S. Dist. LEXIS 9752, at *5 (N.D. Tex. March 10, 2006).</p>
¶ 69	<p>Improper legal opinion (as to whether Keating is exempt from liability, and as to how Keating should use its mark) (FRE 702)</p> <p>Improper factual foundation (FRE 602) (as to how Keating uses its mark on websites and</p>	<p>Franklyn's testimony regarding Keating's use of the term "Bruxer" is appropriate and admissible. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and</p>

Testimony	Keating's Objection	Glidewell's Response
	marketing material)	<p>unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>B & B Hardware, Inc. v. Hargis Industries, Inc.</i>, 252 F.3d 1010, 1012 (8th Cir. 2001) (attorney expert testified as to the distinction of a suggestive mark versus a descriptive mark, and gave his opinion that the mark in question was merely descriptive); <i>Waco Intl, Inc. v. KHK Scaffolding Houston Inc.</i>, 278 F.3d 523, 533 (5th Cir. 2002) (holding that district court did not err by permitting attorney to testify despite arguments that attorney was testifying as to matters of law); <i>Xtreme Lashes, LLC v. Xtended Lashes, LLC</i>, 576 F.3d 221, 232</p>

GLIDEWELL'S RESPONSE TO KEATING'S OBJECTIONS TO
DECL. OF DAVID FRANKLYN SUBMITTED ISO
GLIDEWELL'S MOTIONS FOR PSJ
CASE NO. SACV11-01309 DOC (ANx)

Testimony	Keating's Objection	Glidewell's Response
		<p>(5th Cir. 2009) (expert testimony considered in determining whether EXTEND YOUR BEAUTY was descriptive or suggestive mark); <i>The Fresh Market v. Marsh Supermarkets, Inc.</i>, 2005 WL 2154677 at *3 (N.D. Ind. Sept. 7, 2005) (plaintiff moved to strike expert testimony because it opined on legal question as to likelihood of confusion, district court denied because professor was qualified to testify about consumer habits); <i>Tenneco Auto. Operating Co., Inc. v. Kingdom Auto Parts</i>, 2010 WL 4365580 at * 10-12 (6th Cir. Oct. 28, 2010) (finding trademark attorney's opinion as an expert persuasive as to whether product numbers were protectable marks).</p> <p>Keating's foundational objection is baseless. Franklyn's opinion is based on a myriad of evidence, all of which is set forth throughout his declaration, Paragraphs 4, 5, 43, 44, and 55-69 in</p>

Testimony	Keating's Objection	Glidewell's Response
		particular.
¶ 70	Improper legal opinion (as to whether BruxZir is distinctive) (FRE 702)	<p>Franklyn's testimony regarding distinctiveness is appropriate and admissible. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>B & B Hardware, Inc. v. Hargis Industries, Inc.</i>, 252 F.3d 1010, 1012 (8th Cir. 2001) (attorney expert testified as to the distinction of a suggestive mark versus a descriptive mark, and gave his opinion that the mark in question was merely descriptive); <i>Waco Intl, Inc. v. KHK Scaffolding</i></p>

Testimony	Keating's Objection	Glidewell's Response
		<p><i>Houston Inc.</i>, 278 F.3d 523, 533 (5th Cir. 2002) (holding that district court did not err by permitting attorney to testify despite arguments that attorney was testifying as to matters of law); <i>Xtreme Lashes, LLC v. Xtended Lashes, LLC</i>, 576 F.3d 221, 232 (5th Cir. 2009) (expert testimony considered in determining whether EXTEND YOUR BEAUTY was descriptive or suggestive mark); <i>The Fresh Market v. Marsh Supermarkets, Inc.</i>, 2005 WL 2154677 at *3 (N.D. Ind. Sept. 7, 2005) (plaintiff moved to strike expert testimony because it opined on legal question as to likelihood of confusion, district court denied because professor was qualified to testify about consumer habits); <i>Tenneco Auto. Operating Co., Inc. v. Kingdom Auto Parts</i>, 2010 WL 4365580 at * 10-12 (6th Cir. Oct. 28, 2010) (finding trademark attorney's opinion as an expert persuasive as to whether</p>

Testimony	Keating's Objection	Glidewell's Response
		product numbers were protectable marks).
¶ 71	<p>Improper new evidence (as to the opinions, assertions of fact and conclusions of the dentists) (FRCP 37(c))</p> <p>Improper expert testimony (as to Franklyn's opinion that BruxZir crown or bruxer crown is not generic and as to whether BruxZir has strong brand recognition among dentists, because Franklyn is not a dentistry expert) (FRE 702)</p> <p>Conclusion supported by inadmissible evidence (Franklyn relies on inadmissible statements by the dentists to conclude that the mark was strong for use on zirconia crowns)(FRCP 56(c)(2); 37(c))</p>	<p>Franklyn's testimony is not based on improper new evidence. The dentists Franklyn interviewed were disclosed in Franklyn's rebuttal reports, and in an amended disclosure on October 29, 2012, before the discovery period closed under the Court's Scheduling Order. The rebuttal reports were timely under Fed. R. Civ. Proc. 26(a)(2)(C)(ii) and the Court's Scheduling Order. [Dkt. #15; <i>see also</i> Dkt. #14 (Minute Order).] The amended disclosure was timely and, even if it was not, caused no prejudice as set forth at length Plaintiff James R. Glidewell Dental Ceramics, Inc.'s Response to Defendant Keating Dental Arts, Inc.'s Objections to Evidence Submitted by Glidewell's Dentist Witnesses in Support of its Motions for Partial Summary Judgment.</p> <p>Franklyn can testify as to whether BruxZir,</p>

Testimony	Keating's Objection	Glidewell's Response
		<p>Bruxer or “bruxer” has become generic for a type of dental crown. Utilizing attorney experts, including law professors, to proffer opinion testimony concerning such matters as the strength of a mark, similarity between marks, the potential for customer confusion, and other specialized issues pertinent to a trademark case is a commonly accepted practice. <i>See, e.g., Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i>, 516 F.3d 853, 861-63, (10th Cir. 2008) (attorney/adjunct professor in trademark and unfair competition practice provided expert testimony as to: strength of a service mark, similarity between service marks, possibility of consumer confusion, evidence of intent to utilize or trade on the reputation of a company through use of a similar service mark, and whether the companies were in competition with one another); <i>Children's Med. Center v. Columbia Hosp.</i>, No.</p>

GLIDEWELL'S RESPONSE TO KEATING'S OBJECTIONS TO
DECL. OF DAVID FRANKLYN SUBMITTED ISO
GLIDEWELL'S MOTIONS FOR PSJ
CASE NO. SACV11-01309 DOC (ANx)

Testimony	Keating's Objection	Glidewell's Response
		<p>3-04-2436-BD, 2006 U.S. Dist. LEXIS 9752, at *5 (N.D. Tex. March 10, 2006).</p> <p>Franklyn may rely in part on the dentist interviews he conducted, even if the dentist interviews were inadmissible, to support his opinions, because a statement regarding the strength of the BruxZir mark is the type of evidence that an expert would reasonably rely on. Fed. R. Evid. 703; <i>See United States v. Hankey</i>, 203 F.3d 1160, 1169 (9th Cir. 2000) (reliability based on training, experience, and personal knowledge).</p>

Glidewell Laboratories v. Keating Dental Arts, Inc.
United States District Court, Central, Case No. SACV11-01309-DOC (ANx)

CERTIFICATE OF SERVICE

I hereby certify that on December 3, 2012, I electronically filed the document described as **PLAINTIFF JAMES R. GLIDEWELL DENTAL CERAMICS, INC. DBA GLIDEWELL LABORATORIES' RESPONSE TO DEFENDANT KEATING DENTAL ARTS, INC.'S OBJECTIONS TO DECLARATION AND EXPERT REPORTS OF DAVID FRANKLYN SUBMITTED IN SUPPORT OF GLIDEWELL'S MOTIONS FOR PARTIAL SUMMARY JUDGMENT** with the Clerk of the Court using the CM/ECF System which will send notification of such filing to the following:

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